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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,441	08/15/2000	Douglas M. Okuniewicz		1938
32009	7590	10/09/2003	EXAMINER	
BRADLEY ARANT ROSE & WHITE LLP 200 CLINTON AVE. WEST SUITE 900 HUNTSVILLE, AL 35801			NGUYEN, BINH AN DUC	
		ART UNIT	PAPER NUMBER	
		3713		

DATE MAILED: 10/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/639,441	OKUNIEWICZ, DOUGLAS M.
	<b>Examiner</b>	<b>Art Unit</b>
	Binh-An D. Nguyen	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 July 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other:

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## DETAILED ACTION

1. The Amendment with Declaration of an Interference and Power of Attorney filed in Papers No. 4 and 5, respectively, July 16, 2003 have been received. According to the Amendment, claims 1, 2, 4, 9, and 10 have been amended. Currently, claims 1-10 are pending in the application.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 9, the recited limitation "read-only detection means" has not been originally disclosed.
4. Claims 1-10 of this application are asserted by applicant to correspond to claims 1-6, 8, 9, 10, 13, and 14 (Applicant's proposed Count 1) and claims 17-22, 24-27, 29, and 32-34 (Applicant's proposed Count 2) of U.S. Patent No. 6,113,098.

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The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 6,113,098 because the limitations as claimed by the applicant do not correspond to the claimed limitations of claims 1-6, 8, 9, 10, 13, and 14 (Applicant's proposed Count 1) and claims 17-22, 24-27, 29, and 32-34. In Counts 1 and 2, the applicant's claims lack the combined limitations of means for receiving a wager; means for randomly determining at least one of a plurality of possible outcomes; means of providing a gaming award in a form selected from the group consisting of coins, currency, credits or redeemable tickets in response to said determining means; and means for dispensing tickets (or supplemental tickets) which is operable independent of said determining means (or said game award wherein said supplemental tickets are different from said gaming award) as claimed by Adam. Accordingly, an interference cannot be initiated based upon this claim.

5. Claims 1-10 of this application, have been asserted by applicant to correspond to claims 1-6, 8, 9, 10, 13, and 14 (Applicant's proposed Count 1) and claims 17-22, 24-27, 29, and 32-34 (Applicant's proposed Count 2) of U.S. Patent No. 6,113,098. These claims are not patentable to the applicant because claims 1-10 are being rejected by Kelly et al. (5,816,918) as discussed below.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (5,816,918).

Kelly et al. teaches a printing and dispensing bonusing system for electronic gaming devices comprising: at least one detection means adapted for connection to an electronic apparatus, said detection means operative to detect selected event occurrences on an electronic apparatus and output event occurrence notification signals upon detection of an event (detecting inputs from player/operator) (6:64-7:51); event detection sampling means in information transmission connection with said detection means, said event detection sampling means operative to detect and receive occurrence notification signals from said detection means, analyze said event occurrence notification signals and output event occurrence information signals including information specifying selected event occurrences (7:19-8:30); event occurrence information signal computing means in information transmission connection with said event detection sampling means, said signal computing means operative to receive and analyze said selected event occurrence information signals output by said event detection sampling means and upon detection of selected event occurrence information signals, output command signals for initiating at least one bonus

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printing/dispensing device connected to said programmable event occurrence information signal computing device (7:52-9:8); said at least one bonus printing/dispensing device independent of a standard output device of the electronic gaming device and operative to accept command signals from a programmable event occurrence information signal computing device and to print and dispense bonus information and awards resulting from selected events occurring on the electronic gaming device whereby an operator/player of the electronic gaming device is awarded selected bonus information and awards (9:9-10:65); event detection sampling means comprises at least one input register operative to monitor said detection means such that any event occurrence on said electronic apparatus will be detected and stored for access by said event occurrence information signal computing means (storing input data in RAM); said event detection sampling means is operative to receive and analyze said event occurrence signals output by an electronic apparatus to determine the specific event that has occurred in an electronic apparatus, said event detection sampling means operative to store said event in data storage registers within said event detection sampling means; said event occurrence information signal computing means comprises a programmable microcontroller chip programmed to scan said data storage registers within said event detection sampling means and remove , identify and compare a selected event occurrence notification signal found within a selected data storage register of said event detection sampling means with an event occurrence table encoded into data storage registers within said event occurrence information signal

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computing means (see Figs. 5b, 6a, 6b, and 8a), said table corresponding to selected event occurrence information signals which in turn correspond to particular event occurrences on an electronic apparatus (12:41-14:10); said event occurrence information signal computing means further is operative to identify a match of an event occurrence information signal and an event occurrence number within said registers of said event occurrence information signal computing means, said event occurrence information signal computing means operative to output one of said command signals related to said event occurrence number to at least one of said connected bonus printing/dispensing device (10:26-52 and 12:12-30); said at least one bonus printing/dispensing device comprises at least one printing device operative to dispense a printed ticket or voucher representative of the selected bonus item; said at least one printing/dispensing device comprises at least one dispensing device which is operative to output bonus items include bonus tickets or promotional materials. See also, Figures 1-9b columns 1-42.

Note, the limitation of detection means comprises a plurality of optical isolators (claim 2) is inherent from the computer related systems. Further, the optical isolators commonly used in computer circuitry may be considered as read-only detection means. Furthermore, regarding the using of different terms in claims 1-10 such as event detection sampling in information transmission connection with the detection means, and event occurrence information signal computing means in information transmission

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connection with the event detection sampling means, these are alternative languages for different functions of a conventional game detection units.

8. Applicant's arguments filed in Paper No. 4 have been fully considered but they are not persuasive. Regarding applicant's remarks that the present application explicitly claims a system for electronic gaming devices that receives input from the circuit board of the device and there is absolutely no input from the user that can determine or effect the outcome of the game (applicant's Response, numeral 4(a), last paragraph), these are not convincing because: first, this has not been claimed; secondly, the transmitted signals from the circuit board of the input devices would bring the same processing results and affects to the gaming system as being addressed above.

9. Further, applicant's requested references (applicant's Response, numeral 4(b)) relating to utilization of optical sensors as detection means are hereby provided.

The references are:

Akenkalin et al. (3,417,249).

Fiorenza et al. (4,069,488).

Acres (6,319,125).

Acres et al. (5,655,961).

Fleming et al. (4,100,597).

Chun et al. (4,280,221).

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

BT<sup>2</sup>  
BN

*Teresa Walberg*  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700